

### **REMARKS**

Claims 1-40 are pending in the above-identified application. Claims 1-40 were rejected. With this Amendment, claims 1, 12, 21, 29, 36, and 40 were amended, no claims were added and claims 7 and 26 were cancelled. Accordingly, claims 1-6, 8-25, and 27-40 are at issue.

Claims 1, 12, 21, 29, 36, and 40 were amended to recite “when transmitting said person identification certificate to said person authentication system, said person identification certificate authority retrieves a stored encrypted template, decrypts the stored encrypted template using a private key of the person identification certificate authority, re-encrypts the decrypted template using a public key of said person authentication system to which said person identification certificate is to be transmitted, and stores the re-encrypted template in said person identification certificate.” Support for this amendment may be found, *inter alia*, at paragraphs 0332 to 0341 and Figure 22 of the published patent application.

#### **I. Objection To Claims**

The Examiner objected to claims 1, 12, 21, 29 and 40 for containing informalities. Those informalities are resolved by this Amendment.

The Examiner objected to claims 12, 29, and 36 for lacking transitional phrases. Applicants note that claim 12 includes the transitional phrase “said system comprising.” Transitional language has been add to claims 29 and 36 by this Amendment.

#### **II. 35 U.S.C. § 112 Written Description Rejection of Claims**

Claims 1-40 were rejected under 35 U.S.C. § 112, first paragraph, as being indefinite for failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Examiner asserts that claims 1, 12, 21, 29, 36 and 40 recite limitations directed to subject matter not sufficiently described in the specification. Specifically, the Examiner asserts that encrypting sampling information using a public key is not supported. In response, Applicants assert that the subject matter is sufficiently described in the specification at, for example, paragraph 0300 of the published application. Accordingly, Applicants request withdrawal of the rejection.

**III. 35 U.S.C. § 101 Claim Rejections**

Claim 40 was rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. Amended claim 40 now recites computer storage medium for storing a computer program. Applicants respectfully submit that this rejection is moot in view of this Amendment.

**IV. 35 U.S.C. § 102 Anticipation Rejection of Claims**

Claims 1, 9, 21, 28, 26, 38 and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bianco et al. (U.S. Patent No. 6,256,737). Applicant respectfully traverses this rejection.

As amended, claim 1 recites “when transmitting said person identification certificate to said person authentication system, said person identification certificate authority retrieves a stored encrypted template, decrypts the stored encrypted template using a private key of the person identification certificate authority, re-encrypts the decrypted template using a public key of said person authentication system to which said person identification certificate is to be transmitted, and stores the re-encrypted template in said person identification certificate.” Applicants respectfully submit that Bianco fails to teach these limitations. Accordingly,

Applicants submit that claim 1 is patentable over the cited art, as well as dependent claims 2-6 and 8-11.

For the same reasons as discussed above with respect to claim 1, independent claims 21 and 40, as well as dependent claims 22-25, 27, and 28, are also patentable over the cited art.

**V. 35 U.S.C. § 103 Obviousness Rejection of Claims**

Claims 1-3, 8, 10, 21-23, 36, 37, 39 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dulude et al. (U.S. Patent No. 6,310,966) in view of Schneier, "Applied Cryptography," 1996, pp. 31-32. Claims 6 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dulude et al. (U.S. Patent No. 6,310,966) in view of Schneier, "Applied Cryptography," 1996, pp. 31-32, further in view of Vaeth et al. (U.S. Patent No. 6,035,402). Claims 5, 7, 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dulude et al. (U.S. Patent No. 6,310,966) in view of Schneier, "Applied Cryptography," 1996, pp. 31-32, and further in view of Hughes ("Digital Envelopes and Signatures," InstantDoc#2698, WindowsITPro, September 1996). Claims 4, 11 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bianco in view of Diffie et al. "Authentication and Authenticated Key Exchanges," Designs, Codes and Cryptography, Kluwer Academic Publishers, 1992. Claims 12-14, 16-18, 20, 29-31, 33, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu et al. (U.S. Patent No. 5,930,804) in view of Dulude et al. (U.S. Patent No. 6,310,966 further in view of Schneier, "Applied Cryptography," 1996, pp. 31-32. Claims 19 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu et al. (U.S. Patent No. 5,930,804) in view of Dulude et al. (U.S. Patent No. 6,310,966) in view of Schneier, "Applied Cryptography," 1996, pp. 31-32 and in view of Oishi (U.S. Patent No. 6,298,153). Applicant

respectfully traverses this rejection. Claims 15 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu et al. (U.S. Patent No. 5,930,804) in view of Dulude et al. (U.S. Patent No. 6,310,966) further in view of Schneier, "Applied Cryptography," 1996, pp. 31-32. Applicant respectfully traverses these rejections.

As amended, claim 1 recites "when transmitting said person identification certificate to said person authentication system, said person identification certificate authority retrieves a stored encrypted template, decrypts the stored encrypted template using a private key of the person identification certificate authority, re-encrypts the decrypted template using a public key of said person authentication system to which said person identification certificate is to be transmitted, and stores the re-encrypted template in said person identification certificate." Applicants respectfully submit that none of the cited art teaches or suggests these limitations. Accordingly, Applicants submit that claim 1 is patentable over the cited art, as well as dependent claims 2-6 and 8-11.

For the same reasons as discussed above with respect to claim 1, independent claims 12, 21, 29, 36 and 40, as well as dependent claims 13-20, 22-25, 27, 28, 30-35, and 37-39, are also patentable over the cited art.

**VI. Double Patenting Rejection of Claims**

Claims 1-5, 7, 10, 12-15, 20-26, 29-32, 36-38 and 40 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,059,516 in view of Schneier, "Applied Cryptography," 1996, pp. 31-32. Applicants traverse this rejection.

As amended, claim 1 recites "when transmitting said person identification certificate to said person authentication system, said person identification certificate authority retrieves a stored encrypted template, decrypts the stored encrypted template using a private key of the person identification certificate authority, re-encrypts the decrypted template using a public key of said person authentication system to which said person identification certificate is to be transmitted, and stores the re-encrypted template in said person identification certificate." Applicants respectfully submit neither the '516 patent nor Schneier teaches or suggests these limitations. Accordingly, Applicants submit that claim 1 is patentable, as well as dependent claims 2-6 and 8-11.

Claims 1, 2, 5-7, 10, 12, 13, 20-22, 25-27, 30, 36, 37, 39 and 40 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending U.S. Patent Application No. 09/944,424 in view of Schneier, "Applied Cryptography," 1996, pp. 31-32. Applicants traverse this rejection.

As amended, claim 1 recites "when transmitting said person identification certificate to said person authentication system, said person identification certificate authority retrieves a stored encrypted template, decrypts the stored encrypted template using a private key of the person identification certificate authority, re-encrypts the decrypted template using a public key

of said person authentication system to which said person identification certificate is to be transmitted, and stores the re-encrypted template in said person identification certificate.” Applicants respectfully submit neither the ‘424 application nor Schneier teaches or suggests these limitations. Accordingly, Applicants submit that claim 1 is patentable, as well as dependent claims 2-6 and 8-11.

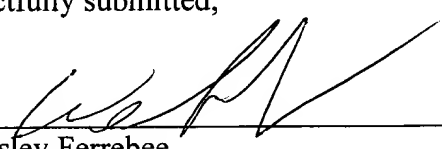
For the same reasons as discussed above with respect to claim 1, independent claims 12, 21, 29, 36 and 40, as well as dependent claims 13-20, 22-25, 27, 28, 30-35, and 37-39, are also patentable.

## **VII. Conclusion**

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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